REMARKS

I. Status of Claims

Claims 1-41 are currently pending in this application. Claim 41 has been withdrawn.

II. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-40 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants respectfully traverse this rejection for the reasons set forth below.

First, the Office asserts that the word "including" in claim 1 is "open ended." (*See* page 2 of the Office Action.) It is unclear to Applicants whether the Office is rejecting the claim on this basis because the Office has failed to articulate a reason why this term could render the claim indefinite other than this conclusory statement. While Applicants agree that "including" is open ended, open-endedness is not a valid basis for rejection under § 112, second paragraph. A claim is not infinite as long as the boundaries of the claim are capable of being understood by one of ordinary skill in the art. *See* M.P.E.P. § 2173.04. Because the Office has provided no explanation to the contrary, this basis for rejection should be withdrawn.

Second, the Office asserts that the term "derivatives" in claim 1 is unclear. (*See* page 2 of the Office Action.) Applicants assert that this term is not "unclear," as "derivative" is a widely used term in the chemical art. Moreover, the Office has failed to provide sufficient basis for the contention that it is unclear, again only providing a conclusory statement. Therefore, this basis for rejection should also be withdrawn.

III. Rejections Under 35 U.S.C. § 103

The Office has also rejected claims 1-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,793,994 ("the '994 patent"). Applicants respectfully traverse this rejection for the reasons set forth below.

In making a rejection under 35 U.S.C. § 103, the Office has the initial burden to establish a *prima facie* case of obviousness. *See* M.P.E.P. § 2143. To meet this burden, the Office must point to some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify the reference's teachings with a reasonable expectation of success. *See* M.P.E.P. §§ 2143.01 and 2143.02; *In re Fine,* 5 U.S.P.Q.2d 1596, 1598, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art reference, not in Applicants' disclosure. *See In re Vaeck*, 20 U.S.P.Q.2d 1438, 947 F.2d 488 (Fed. Cir. 1991). Applicants submit that the Office has not met either of these criteria with respect to the proposed modifications of the '994 patent, and therefore, the Office has failed to meet its initial burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, and the rejection should be withdrawn.

First, the Office improperly bases its finding of obviousness on the assertion that every element of the invention and the invention as a whole are "fairly suggested" by the '994 patent and the claims of the present application differ only in that they are directed to "a method for lanthanizing keratin fibers to achieve relaxation of the said fibers," whereas the '944 patent teaches a method of straightening hairs using similar compounds. (*See* page 4 of the Office Action.) Applicants submit that the Office has

failed to explicitly set forth sufficient evidence of a motivation to combine the elements of the present claims based on the disclosure of the '994 patent and, therefore, has not established a *prima facie* case of obviousness. *See In re Lee,* 61 U.S.P.Q.2d 1430, 1433, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Instead, the Office has merely pointed to disclosure of some of the individual components of the present claims in the '994 patent and has not revealed any motivation to arrive at the specific claimed method. For example, the '994 patent does not disclose each of the specific steps of the method in the present claims, as set forth in claim 1, including the rinsing and heating steps.

Moreover, the '994 patent actually teaches away from the present invention, stating that reducing agents, such as thioglycolates cause damage to the hair. *See* col. 1, lns. 64-66. Therefore, one would actually be discouraged from developing a method using thioglycolates, contrary to the Office's assertion that such combination is "fairly suggested" by the '994 patent.

Second, only in hindsight could it have been obvious to one with the '994 patent before her to have arrived at the claimed method with any reasonable expectation of success, and such use of hindsight reconstruction is impermissible. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600, 837 F.2d 1071, 1075 (Fed. Cir. 1988). As stated above, the '994 patent does not teach or suggest that the particular combination of steps, including using thioglycolates as reducing agents and hydroxide compounds as oxidizing agents, in the presently claimed method would relax keratin fibers. In fact, the '944 patent teaches that the inclusion of a N-alkyl-lactam is necessary to overcome the damaging effects of the use of thioglycolates. *See* col. 7, lns. 6-10. Accordingly, one of ordinary

skill in the art would not have had the requisite reasonable expectation of success in the method of the present claims based on the teachings of the '994 patent.

In the absence of "clear and particular evidence" of a motivation to combine the elements of the present claims and an expectation of success from such combination, the rejection should be withdrawn. In light of the foregoing, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness, and thus, request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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